Amendments

Claim 7 was amended to correct a typographical error. The superscript in R^2 was inadvertently listed as a subscript. Support for this amendment can be found in the specification for example in the definition for R^2 disclosed on page 5.

Requirement for Restriction

The Examiner has indicated that restriction to on of the following inventions is required under 35 U.S.C. § 121. The Examiner has used the following abbreviations to define the groups.

G1: Subgenus encompasses the compounds disclosed in applications 08/904,415; 08/903,585; 08/904,423; 08/920,353; 08/904,417; 08/920,394; and 08/904,416.

G2: Subgenus encompassing the compounds of Claim 7, wherein R_1 and R_2 form a ring.

G3: Subgenus encompassing the compounds of Claim 7, wherein R_1 and R_2 do not form a ring.

Further, the Examiner has required restriction to the following inventions:

Group 1. Claims 1-6, 9, and 10, drawn to compounds which include G1, but exclude G2 and G3.

Group 2. Claims 1-7, 9, and 10, drawn to compounds which include G2, but exclude G1 and G3.

Group 3. Claims 1-10, drawn to compounds which include G3, but exclude G1 and G2.

Group 4. Claims 11-15, drawn to a method for screening compounds which include G1, but exclude G2 and G3.

Group 5. Claims 11-16, drawn to a method for screening compounds which include G2, but exclude G1 and G3.

Group 6. Claims 11-17, drawn to a method for screening compounds which include G3, but exclude G1 and G2.

Group 7. Claims 18-21, drawn to a method of treating an inflammatory condition by administering a compound which includes G1, but which excludes G2 and G3.

Group 8. Claims 18-22, drawn to a method of treating an inflammatory condition by administering a compound which includes G2, but which excludes G1 and G3.

Group 9. Claims 18-23, drawn to a method of treating an inflammatory condition by administering a compound which includes G3, but which excludes G1 and G2.

In response Applicants elect Group 1 with traverse. Applicants respectfully traverse this requirement for restriction, for the following reasons.

Initially, page 2 of the Office Action requested Applicants to note if there is an overlap between the compounds of G1 and the compounds of G2 and G3. In this regard, one or more the applications cited in G1 include compounds which are believed to overlap with the compounds of G2 and G3. For example, U.S. Serial No. 08/903,585 defines compounds where R^1 and R^2 do not form a ring. Likewise, U.S. Serial No. 08/904,423 defines compounds where R^1 and R^2 may or may not form a ring. Accordingly, Applicants submit that the restriction requirement is improper, if for no other reason, because it does not provide for unique groupings of compounds.

In any event, an application may be properly restricted to one of two or more claimed inventions if (a) the inventions are independent and distinct as claimed; and (b) a serious

burden is imposed on the Examiner if restriction is not required. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it in the merits, even though it includes claims to independent and distinct inventions. See MPEP § 803. Moreover, the Examiner must provide reasons and/or examples to support conclusions regarding a need for restriction, but need not cite documents to support the requirement in most cases. See MPEP § 803 "GUIDELINES".

In the present case, the Examiner has indicated that restriction of the subject matter into 9 groups is required, i.e., Groups 1-3 drawn to the linear and cyclic pharmaceutical compositions, Groups 4-6 drawn to a method of screening compounds and Groups 7-9 drawn to a method of treating an inflammatory condition by administering a compound drawn to the linear and cyclic compounds of Group 1-3.

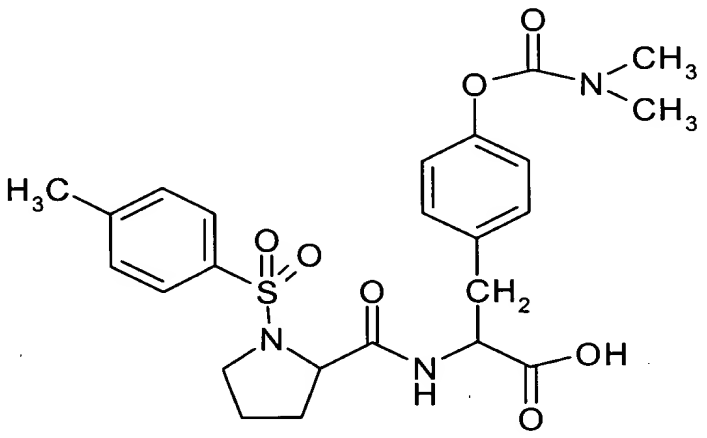
Applicants submit that this restriction requirement is not proper as drawn to the pharmaceutical composition claims. Specifically, as noted above, Groups 1-3 do not define unique compounds but, in fact, the compounds of Group 1 are believed to overlap with the compounds of Groups 2 and 3. Applicants submit that restriction may be proper if a two way restriction requirement was presented relative to Groups 2 and 3. That is to say that one group is directed to compounds where R^1 and R^2 form a ring and a second group directed to compounds where R^1 and R^2 do not form a ring.

Applicants further submit that restriction of the pharmaceutical composition claims from the method claims is improper. Applicants submit that a search of the pharmaceutical compounds would also likely be relevant to the methods of treating an inflammatory condition by administering the pharmaceutical compositions thereof. In fact, one would expect to find the reference to pharmaceutical compositions and the methods for treating the conditions in the same documents.

According, Applicants submit that an undue burden would not be imposed on the Examiner if these groups were examined togther and Applicants respectfully request that this restriction requirement be withdrawn.

Election of Species

The Examiner has also indicated that Applicants required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits. In response, Applicants elect as their single disclosed specie:



This compound is named N-(toluene-4-sulfonyl)-L-prolyl-L-4(N,N-dimethylcarbamyloxy)phenylalanine. This compound is disclosed in the specification, starting on page 4 and is found as compound 2 in Claim 4.

In this regard and as it relates to elected Group 1, Claims 1-6 and 9-10 are believed to read on the elected species. In point of fact, Applicants submit that this species also reads on Claims 7 and 8 and further evidences the error in the restriction requirement.

In view of the above, early examination of this application is earnestly solicited.

Respectfully submitted,

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